

PATENT COOPERATION TREATY

16

From the
INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY

PCT

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NOTIFICATION OF TRANSMITTAL OF THE INTERNATIONAL PRELIMINARY EXAMINATION REPORT

(PCT Rule 71.1)

Date of mailing
(day/month/year) 20.12.2004

Applicant's or agent's file reference
37960/GM/p

IMPORTANT NOTIFICATION

International application No.
PCT/EP 03/08790

International filing date (day/month/year)
07.08.2003

Priority date (day/month/year)
19.09.2002

Applicant
URETEK S.R.L. et al.

1. The applicant is hereby notified that this International Preliminary Examining Authority transmits herewith the international preliminary examination report and its annexes, if any, established on the international application.
2. A copy of the report and its annexes, if any, is being transmitted to the International Bureau for communication to all the elected Offices.
3. Where required by any of the elected Offices, the International Bureau will prepare an English translation of the report (but not of any annexes) and will transmit such translation to those Offices.

4. REMINDER

The applicant must enter the national phase before each elected Office by performing certain acts (filing translations and paying national fees) within 30 months from the priority date (or later in some Offices) (Article 39(1)) (see also the reminder sent by the International Bureau with Form PCT/IB/301).

Where a translation of the international application must be furnished to an elected Office, that translation must contain a translation of any annexes to the international preliminary examination report. It is the applicant's responsibility to prepare and furnish such translation directly to each elected Office concerned.

For further details on the applicable time limits and requirements of the elected Offices, see Volume II of the PCT Applicant's Guide.

The applicant's attention is drawn to Article 33(5), which provides that the criteria of novelty, inventive step and industrial applicability described in Article 33(2) to (4) merely serve the purposes of international preliminary examination and that "any Contracting State may apply additional or different criteria for the purposes of deciding whether, in that State, the claimed inventions is patentable or not" (see also Article 27(5)). Such additional criteria may relate, for example, to exemptions from patentability, requirements for enabling disclosure, clarity and support for the claims.

Name and mailing address of the international
preliminary examining authority:



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PATENT COOPERATION TREATY

PCT

INTERNATIONAL PRELIMINARY EXAMINATION REPORT

(PCT Article 36 and Rule 70)

Applicant's or agent's file reference 37960/GM/p	FOR FURTHER ACTION See Notification of Transmittal of International Preliminary Examination Report (Form PCT/PEA/416)	
International application No. PCT/EP 03/08790	International filing date (<i>day/month/year</i>) 07.08.2003	Priority date (<i>day/month/year</i>) 19.09.2002
International Patent Classification (IPC) or both national classification and IPC E04B1/64		
Applicant URETEK S.R.L. et al.		
<p>1. This international preliminary examination report has been prepared by this International Preliminary Examining Authority and is transmitted to the applicant according to Article 36.</p> <p>2. This REPORT consists of a total of 5 sheets, including this cover sheet.</p> <p><input type="checkbox"/> This report is also accompanied by ANNEXES, i.e. sheets of the description, claims and/or drawings which have been amended and are the basis for this report and/or sheets containing rectifications made before this Authority (see Rule 70.16 and Section 607 of the Administrative Instructions under the PCT).</p> <p>These annexes consist of a total of sheets.</p>		
<p>3. This report contains indications relating to the following items:</p> <p>I <input checked="" type="checkbox"/> Basis of the opinion</p> <p>II <input type="checkbox"/> Priority</p> <p>III <input type="checkbox"/> Non-establishment of opinion with regard to novelty, inventive step and industrial applicability</p> <p>IV <input type="checkbox"/> Lack of unity of invention</p> <p>V <input checked="" type="checkbox"/> Reasoned statement under Rule 66.2(a)(ii) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement</p> <p>VI <input type="checkbox"/> Certain documents cited</p> <p>VII <input type="checkbox"/> Certain defects in the international application</p> <p>VIII <input type="checkbox"/> Certain observations on the international application</p>		
Date of submission of the demand 08.04.2004	Date of completion of this report 20.12.2004	
Name and mailing address of the international preliminary examining authority:  European Patent Office D-80298 Munich Tel. +49 89 2399 - 0 Tx: 523656 epmu d Fax: +49 89 2399 - 4465	Authorized Officer Rosborough, J Telephone No. +49 89 2399-2818 	

INTERNATIONAL PRELIMINARY
EXAMINATION REPORTJC20 Rec'd PCT/PTO 10 MAY 2005
International application No. PCT/EP 03/08790

I. Basis of the report

1. With regard to the **elements** of the international application (*Replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to this report since they do not contain amendments (Rules 70.16 and 70.17):*

Description, Pages

1-16 as originally filed

Claims, Numbers

1-35 as originally filed

Drawings, Sheets

1/4-4/4 as originally filed

2. With regard to the **language**, all the elements marked above were available or furnished to this Authority in the language in which the international application was filed, unless otherwise indicated under this item.

These elements were available or furnished to this Authority in the following language: , which is:

- ☐ the language of a translation furnished for the purposes of the international search (under Rule 23.1(b)).
- ☐ the language of publication of the international application (under Rule 48.3(b)).
- ☐ the language of a translation furnished for the purposes of international preliminary examination (under Rule 55.2 and/or 55.3).
3. With regard to any **nucleotide and/or amino acid sequence** disclosed in the international application, the international preliminary examination was carried out on the basis of the sequence listing:
- ☐ contained in the international application in written form.
- ☐ filed together with the international application in computer readable form.
- ☐ furnished subsequently to this Authority in written form.
- ☐ furnished subsequently to this Authority in computer readable form.
- ☐ The statement that the subsequently furnished written sequence listing does not go beyond the disclosure in the international application as filed has been furnished.
- ☐ The statement that the information recorded in computer readable form is identical to the written sequence listing has been furnished.
4. The amendments have resulted in the cancellation of:
- ☐ the description, pages:
- ☐ the claims, Nos.:
- ☐ the drawings, sheets:

**INTERNATIONAL PRELIMINARY
EXAMINATION REPORT**

International application No. **PCT/EP 03/08790**

5. ☐ This report has been established as if (some of) the amendments had not been made, since they have been considered to go beyond the disclosure as filed (Rule 70.2(c)).

(Any replacement sheet containing such amendments must be referred to under item 1 and annexed to this report.)

6. Additional observations, if necessary:

V. Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. Statement

Novelty (N)	Yes: Claims	1-35
	No: Claims	
Inventive step (IS)	Yes: Claims	
	No: Claims	1-35
Industrial applicability (IA)	Yes: Claims	1-35
	No: Claims	

2. Citations and explanations

see separate sheet

Re Item V

Reasoned statement with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

Reference is made to the following documents:

D1: DE 196 53 282 C

D2: US-B-6 309 493.

5.1 Inventive step, independent claim 1.

The present application does not meet the criteria of Article 33(1) PCT, because the subject-matter of claim 1 does not involve an inventive step in the sense of Article 33(3) PCT.

Document **D1**, regarded as being the closest prior art to the subject-matter of claim 1, discloses (the references in parentheses applying to this document):

- a method for waterproofing wall systems, consisting:
- in providing spaced injection holes (2) within a wall system (1) in a manner suitable to pass through cavities that exist in the wall system;
- in inserting injecting tubes (9) in said injecting holes;
- in injecting in said injection holes, through said injection tubes, a substance (claim 1, lines 53,54).

The subject-matter of claim 1 therefore differs from this known method in that:

A) the said substance expands after injection as a consequence of a chemical reaction.

The problem to be solved by the present invention may therefore be regarded as:

- to improve the extent of penetration of the substance into the cavities of the wall system.

The solution proposed in claim 1 of the present application cannot be considered as involving an inventive step (Article 33(3) PCT), as feature A) is described in document D2 (claim 1, step d) as providing the same advantages as in the present application. The skilled person would therefore regard it as a normal option to include this feature in the method described in document D1 in order to solve the problem posed.

5.2 Dependent Claims 2-35.

Dependent claims 2-35 do not appear to contain any additional features which, in combination with the features of any claim to which they refer, meet the requirements of the PCT with respect to novelty and inventive step (Article 33(2),(3) PCT), as said additional features are either also disclosed in the documents cited above with regard to the independent claims, or would be employed by the skilled person, if required, either on the basis of his expert knowledge alone or by way of combination with a disclosure from the cited state of the art.

6. Further Comments.

6.1 Clarity, claims.

Several dependent claims do not meet the requirements of Article 6 PCT, as the use of the expression "according to one or more of the preceding claims" (emphasis added) renders them unclear.

For example, claim 5 contradicts claim 4 and the extremely large number of possible combinations of features of each of the dependent claims is not supported by the description.

6.2 Prior Art.

Documents D1 and D2 have not been identified in the description and the relevant background art disclosed therein has not been discussed (Rule 5.1(a)(ii) PCT).